

REMARKS

(A) STATUS OF THE APPLICATION

Applicants thank the Examiner for comments in the Non-Final Office Action dated January 17, 2007.

(I) DISPOSITION OF CLAIMS

- (i) Claims 1, 4, 7, and 10 are pending in the application.
- (ii) Claims 2-3, 5-6, and 8-9 were previously canceled.
- (iii) Claims 1, 4, 7, and 10 are rejected.

(II) APPLICANTS' ACTION

- (i) Applicants respond to the rejections under 35 U.S.C. §§ 112, 2nd ¶; & 103(a).

B. RESPONSE TO REJECTION UNDER 35 U.S.C. § 112, 2ND ¶

Claims 1, 4, 7, and 10 are rejected under 35 U.S.C. § 112, 2nd Paragraph, as indefinite. According to the Examiner, the language in Claim 1, "hydroxy-C2-C4-alkyl (met)acrylate component is selected from the group consisting of hydroxyethylacrylate and hydroxypropylacrylate. . .is confusing because the recited species do not encompass C4 alkyl groups or methacrylate groups."

In response, Applicants have amended Claim 1 to remove the alleged confusion. While Applicants respectfully disagree with the Examiner's position on the indefiniteness of Claim 1 (and 4, 7, and 10 by extension), only in order to advance prosecution, Applicants have amended Claim 1. Applicants note that said amendment does not surrender any claim scope.

C. RESPONSE TO REJECTION UNDER 35 U.S.C. § 103(A) OVER WO 01/25359 (Eq. U.S. PATENT NO. 6,825,241)-CLAIMS 1, 4, 7, & 10

Claims 1, 4, 7, & 10 remain rejected under 35 U.S.C. § 103(a) as being obvious over WO 01/25359 (Equivalent U.S. Patent No. 6,825,241) to Blum, *et al.* (*hereinafter* "Blum").

Applicants respectfully traverse these rejections.

First, Applicants note that the subject matter of the claims in consideration was commonly owned at the time the inventions were made.

Applicants previously submitted two affidavits from the first named inventor Dr. Carmen Flosbach under 37 C.F.R. § 1.132 ("the 132 Declarations"). According to the Examiner, the [132] [D]eclarations are deficient because the examples of the declaration are not commensurate in scope with the claims. Further, according to the Examiner, the claims in the present application "encompass fractional values of X and molar ratios of the diols that are not exemplified within the declaration." The Examiner further suggests that a relevant showing would be where X is equal to 2.5 because that is what the prior art exemplifies.

In relation to the ranges in Claim 1, the Examiner noted that "a limited showing of criticality is insufficient to support a broadly claimed range." Applicants do not disagree with the Examiner's point, except that it does not apply to the present situation. Particularly, criticality of a range is only at issue where the range is needed to establish the nonobviousness of the invention. See MPEP § 2144.05(III). Here, Applicants have made no assertion, and require no assertion, that the ranges in Claim 1 are critical to the nonobviousness of the claim. The ranges are not critical to the *patentability* of the Claim 1 invention but rather are important to the *operability* of the invention. Applicants' Specification confirms the purpose of the Claim 1 ranges at Page 2, Line 31 – Page 3, Line 9; and Page 4, Lines 1-9.

Furthermore, in the first 132 Declaration, Applicants even prepared the resin in Example 5 of the Blum reference and compared it with those of the present invention by measuring its acid and scratch resistance.¹ As suggested before, the resins of the present invention showed unexpected results in terms of the scratch and acid resistance over the Blum resins. Moreover, the resins described in said 132 Declaration were prepared with the values of X at 2 and 3. Thus, at least the workability and the possibility of achieving superior results with $X = 2$ and $X = 3$ were demonstrated for the claimed diol combinations serving as building components for the polyurethane diacrylates. Applicants respectfully submit that because data for the two points $X = 2$ and $X = 3$ were submitted in said 132 Declaration, the process in which the value of X is 2.5, a value within the range between 2 and 3 is commensurate with the scope of the claim.²

Because Claims 4, 7, and 10 are dependent claims, which recite even further limitations to the claim that has already been traversed, Applicants rely upon the arguments presented above in rebuttal to the Examiner's assertion that Claims 4, 7, and 10 are obvious over WO 01/25359.

¹ The first 132 Declaration is hereby incorporated by reference.

² Applicants also note that Claim 1 was amended previously to reflect the combinations of diols and hydroxyethylacrylate or hydroxypropylacrylate found in the two 132 Declarations. Applicants respectfully submit that the combination of the two 132 Declarations should be sufficiently commensurate with the scope of Claim 1 so as to demonstrate patentability of the invention.

CONCLUSION

In view of the above remarks, Applicants respectfully submit that the stated grounds of rejection have been properly traversed, accommodated, or rendered moot and that a complete response has been made to the Non-Final Office Action mailed on January 17, 2007.


Therefore, Applicants believe that the application stands in condition for allowance with withdrawal of all grounds of rejection. A Notice of Allowance is respectfully solicited.

If the Examiner has questions regarding the application or the contents of this response, the Examiner is invited to contact the undersigned at the number provided.

Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928.

Respectfully submitted,

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